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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/756,755 | 01/14/2004 | Junichiro Hara | 062709-0125 | 1540 |
| 22428 | 7590 | 10/18/2005 | EXAMINER | |
| FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | FORD, JOHN K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3753 | |

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,755

Applicant(s)

HARA, JUNICHIRO

Examiner

John K. Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/14/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/14/04 + 1/5/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Applicant has submitted one piece of prior art so relevant to the examination of this application that the examiner is strongly requesting a translation of the reference or in lieu of that, a full detailed explanation, by applicant/counsel, of how the bypass valves 36 and 38 are controlled in DE 19818649. Given that this case is undergoing prosecution overseas the examiner believes that this information is in applicant's possession and its materiality is beyond question.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 19818649.

According to the European Search Report submitted by applicant for the examiner's consideration, this is an "X" reference on claims 1 and 5. Since there are five claims in the current application, the Examiner presumes that these "X" designations correspond to the claims upon which the Search Report was based. If that is the case, the examiner awaits applicant's explanation of how the European

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Patent Office applied this reference. It is clear from the last sentence of the English language abstract that temperature control of the engine coolant is controlled by heat exchanger 22 and apparently by actuation/deactuation of valves 36 and 38. If applicant has received an office action rejecting claims similar to these, in any overseas prosecution, a translation of that office action is required to enable the current examiner to render a decision consistent with, or at least cognizant of, the thinking of these overseas' examiners.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19818649 as applied to claims 1 and 5 above, and further in view of Parsons (USP 2,038,193).

While the bypass valves 36 and 38 appear to be temperature controlled, without a translation it is not possible for this Examiner to be sure. In view of the teaching of Parsons, however, with respect to thermostat 9 controlling bypass valve 10, it would have been obvious to have controlled bypass valves 36 and 38 in DE '649 to bypass the heat exchanger 22 when the engine coolant would reach too high a temperature (e.g. boiling) and not to bypass it at lower temperatures (e.g. during start-up) to improve engine performance as is fairly taught in col. 1 lines 15-21 of Parsons and the explanation of "Route C" in Parsons, both explanations being incorporated by reference here.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '649 alone or in view of Parsons as applied to claim 1, and further in view of either Barbier (USP 3,196,630) or Shook (USP 3,872,682).

Shook and Barbier each individually teach evaporator bypasses (see Shook elements 17, 18 and Barbier elements 20, 25 and 21) to improve system performance. To have added such an evaporator bypass to the prior art to gain the performance advantages taught by Shook or Barbier would have been obvious to one of ordinary skill in the art.

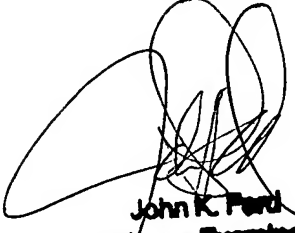
Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '649 alone or in view of Parsons as applied to claim 1 above, and further in view of Burk et al. (US 2001/0052238) or Shook (USP 3,872,682).

To have added an internal heat exchanger, such as 6 in Burk or 13 of Shook, to any of the prior art discussed in reference to claim 1 above to improve the performance of the system would have been obvious to one of ordinary skill in the art. The Burk document is listed as a "Y" document on the European Search report as to claim 4.

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication should be directed to John K. Ford
at telephone number 571-272-4911.



John K. Ford
Primary Examiner